

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte RICHARD L. TAGG

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Appeal No. 1998-3315  
Application 08/739,065

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HEARD: FEBRUARY 7, 2000

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Before FRANKFORT, STAAB and NASE, Administrative Patent Judges.

STAAB, Administrative Patent Judge.

ON REQUEST FOR REHEARING

This case comes before us again on request for rehearing of our decision mailed February 17, 2000, in which we reversed the examiner's rejection of claim 1 under 35 U.S.C. § 112, first paragraph, and affirmed the examiner's rejection of claim 1 under 35 U.S.C. § 112, second paragraph.

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The examiner's rationale for rejecting claim 1 under 35 U.S.C. § 112, second paragraph, was that the term "sides of the socket forming opening" lacked proper antecedent basis. In treating the examiner's rejection of claim 1 under 35 U.S.C.

§ 112, second paragraph, we stated on pages 7 and 8 of our decision that neither appellant's brief nor appellant's reply brief addressed this rejection, that appellant has in effect acquiesced in the rejection, and that, accordingly, this rejection was being summarily affirmed.

Appellant now, for the first time, directly challenges the examiner's rationale. Specifically, appellant now asserts that

the term "sides" is being used for the first time [in the claim] and is not being stated as "said sides" but simply as "sides" of the socket-forming opening in the base. Applicant believes that this is acceptable language and that the Examiner's Section 112, second paragraph, rejection is in error [sic, error] [request, page 1].

The attempt to raise this issue in the request for rehearing is improper and will not be considered. 37 CFR 1.197(b) requires a request for rehearing to state with

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particularity the points believed to have been misapprehended or overlooked in rendering the decision. Since appellant heretofore did not dispute the examiner's conclusion that the terminology "sides of the socket

forming opening" appearing in claim 1 made the claim indefinite within the meaning of the second paragraph of 35 U.S.C. § 112, this point could not have been overlooked or misapprehended in rendering the decision. Moreover and in any event, we do not necessarily agree with appellant's newly presented argument as to why the claim language in question satisfies the requirements of the second paragraph of 35 U.S.C. § 112.

Appellant asks in the alternative that we enter the amendment attached to the request and reconsider the affirmed 35 U.S.C. § 112, second paragraph, rejection of claim 1 in light of said amendment.

We have no authority to reopen prosecution or to enter claim amendments. Moreover, it is not the policy of the Board to consider the effect of amendments filed after a decision

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has been rendered in that we do not have the benefit of the examiner's input as to the merits of the amendments.<sup>1</sup>

Appellant's request for rehearing is granted to the extent of reconsidering our decision, but is denied with respect to making any change therein.

*DENIED*

CHARLES E. FRANKFORT	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
LAWRENCE J. STAAB	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES

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<sup>1</sup> The examiner may, however, recommend entry of the amendment if he considers that it obviously places the case in condition for allowance. See MPEP § 1214.07

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JEFFREY V. NASE )  
Administrative Patent Judge )

ljs/ki

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